

REMARKS

Reexamination and reconsideration of the claims 1-20 are respectfully requested. Applicants apologize for not including the IDS with the last reply. The IDS was mailed, rather than being faxed with the reply. Applicants respectfully request that the Primary Examiner consider the documents submitted in the Information Disclosure Statement dated January 22, 2003 by signing and initialing the same. Additionally, Applicants respectfully request entry of this reply into the record because it places the application in better condition for appeal.

Claims 1, 2, 3, 10, 11, and 12 were rejected under 35 U.S.C. sec. 103(a) applying U.S. Pat. No. 4,865,198 ('198) without a teaching reference. For a patent to be applicable under sec. 103(a), the teaching must, *inter alia*, expressly or inherently, teach, disclose, or otherwise suggest each and every feature of the claimed invention. Additionally, motivation and suggestion to modify the patent must be present. The sec. 103(a) rejection of claims 1, 2, 3, 10, 11, and 12 is respectfully traversed for the following reasons.

Applicants assert that the Office Action fails to address each and every feature of claim 1. Claim 1 recites, *inter alia*, that a first layer contains a first proportion of a dye and a second layer contains a second proportion of dye smaller than the first proportion of dye. The Office Action admits, and Applicants agree, that the '198 patent fails to teach a dye provided in both the first and second layers. See p. 3 of the Office Action dated February 3, 2003. Additionally, the '198 patent fails to teach, disclose, or otherwise suggest proportions of dye in the respective layers.

Applicants assert that the rejection failed to address the recitation of the proportions of dye in the first and second layers in the rejection of claim 1. Moreover, the Office Action

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does not cite any text whatsoever supporting its position. Additionally, the Office Action did not cite any motivation/reasoning why it would have been obvious to modify the '198 patent to use the proportions of dye as recited in the respective layers. Thus, the Office Action failed to make a *prima facie* case of obviousness. For at least this reason, withdrawal of the sec. 103(a) rejection of claims 1, 2, 3, 10, 11, and 12 is warranted and is respectfully requested.

As an independent basis, Applicants assert that the skilled artisan would not have taken a suggestion or been motivated to make the purported modification as suggested in the Office Action. First, the Office Action states that "[i]t would have been obvious to one having ordinary skill in the art to have provided dye in both layers or either layer by itself to have provided the overwrapping package material with a preferred design choice." See p. 3 of the Office Action dated February 3, 2003.

First, stating that features of a claimed invention are a matter of a preferred design choice, without more, does not afford the Applicant a fair opportunity to address the rejection. Moreover, merely stating that features of the claimed invention are a matter of a preferred design choice, without more, is an improper rejection and does not make out a *prima facie* case of obviousness supported by concrete evidence. For this reason alone, the rejection should be withdrawn.

Second, Applicants assert that the Office Action misinterpreted the '198 patent. The skilled artisan would have understood that the '198 patent relates to tamper-evident overwrapped products that clearly provide the consumer with evidence of any attempt at prior entry through an over-wrap film closure. See the '198 patent at Col. 1, ll. 18-22. Moreover, tampering is indicated by movement of the over-wrap with respect the printed package/substrate or vice versa. See the '198 patent at Col. 1,

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11. 25-40.

In other words, the '198 patent requires ink transfer *in register* to the inside surface of the over-wrap. (emphasis added) The '198 patent accomplishes register of images by using a pulsed laser beam to imprint words or symbols on the interior surface of an overlying film by vaporizing ink or pigment from the underlying substrate after the over-wrap film is secured around the package, thereby maintaining register of the images. See the '198 patent at Col. 1, ll. 31-62.

The skilled artisan would have understood that transferring the ink to the over-wrap film *in register* is absolutely essential to the practice of the '198 patent. Specifically, the skilled artisan would have understood that if the ink was not transferred *in register* to the inside surface of the over-wrap film the '198 patent would be inoperable for its intended purpose, namely, providing the consumer with evidence of tampering. Stated another way, if the ink was not *in register*, then the consumer would believe the product had been tampered with and was not suitable for consumption.

Since the '198 patent requires maintaining the register of the images between the over-wrap film and the printed package/substrate, the skilled artisan would not have been motivated or taken a suggestion to modify the '198 patent by providing a dye on the over-wrap film. If the ink was applied to the over-wrap film as asserted in the Office Action, the skilled artisan would have understood that register of images between the over-wrap film and the package/substrate would be nearly impossible to maintain when wrapping the package with the over-wrap film. Stated another way, the skilled artisan would have understood that the over-wrap film having, ink images thereon would have to be perfectly aligned with the ink images on the package when wrapping the package.

Clearly, the skilled artisan would not have been motivated

or taken a suggestion to make the proposed modification. First, the skilled artisan would recognize that aligning images on the over-wrap film and package would be extremely difficult, if not impossible, if an image was on the over-wrap film. Moreover, aligning images in this manner would increase packaging expenses, increase rework and waste, and require more time and quality control. Simply stated, the skilled artisan would not be motivated or taken a suggestion to make the purported modification. Moreover, if the image was already on the over-wrap film the skilled artisan would have understood that there would not be not any reason to use a laser beam, since the laser beam is used to transfer the image to the over-wrap film in register. In other words, there is no reason for the laser beam if the purported modification is made.

Clearly, the objective evidence of record supports the Applicant's position and disparages the purported modification. Moreover, the '198 patent teaches away from the purported modification because it teaches register of images by a mechanism that transfer ink from the package/substrate to the over-wrap film. Thus, the Office Action failed to make a *prima facie* case of obviousness. For at least these reasons, withdrawal of the sec. 103(a) rejection of claims 1, 2, 3, 10, 11, and 12 is warranted and is respectfully requested.

Claims 4-9 and 13-20 were rejected under 35 U.S.C. sec. 103(a) applying the '198 patent in view of U.S. Pat. No. 6,031,457 ('457). For at least the reasons stated above with respect to claim 1, withdrawal of the sec. 103(a) rejection of claims 4-9 is warranted and is respectfully requested. Regarding claims 13-20, as stated above the skilled artisan would not have been motivated to have an exterior layer containing a proportion of dye selected from the group consisting of soot and graphite. Thus, the withdrawal of the sec. 103(a) rejection of claims 13-20 is warranted and is respectfully requested.

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One-hundred and eighty dollars are believed due in connection with this Reply for consideration of the IDS. If any other fees are due in connection with this Reply, please charge any fees, or credit any overpayment, to Deposit Account Number 19-2167.

Allowance of all pending claims is believed to be warranted and is respectfully requested.

The Examiner is welcomed to telephone the undersigned to discuss the merits of this patent application.

Respectfully submitted,

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